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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,656	12/15/2000	An Shun Huang	NBI-858	1573

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EXAMINER

TRAN LIEN, THUY

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 12/19/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/738,656

Applicant(s)
Hwang et al.

Examiner
Lien Tran

Art Unit
1761



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct. 21, 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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1. Claims 1,8,15,19,21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the response filed Oct. 21, 2002, applicant amended the claims to include the limitations “a basecake which is subject to diminished fresh flavor after storage”, “to supply to the basecake during storage over time at least one flavor composition effective to extend freshness perception for the cookie basecake”. These limitations are not supported by the original disclosure. The specification only discloses “flavor-chip containing cookies having an extended shelf life”; there is no discussion what this “extended shelf life” encompasses. There is no discussion of diminished fresh flavor after storage and certainly no discussion of extending freshness perception. Extended shelf life does not equate to “extending freshness perception”. Extended shelf life can mean the cookies are not subjected to molding or other defect during storage; it does not necessarily equate to flavor or freshness perception.

2. Claims 1,8,15,19,21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In all relevant claims, the terms “freshness perception” and “fresh flavor” are indefinite because they are relative terms; what would be considered as “freshness perception” and “fresh flavor”?

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These qualities are subjective evaluation and vary among individuals. The specification does not define the terms.

3. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haynes et al in view of "Original Chocolate Chip Cookies Recipes" for the same reason set forth in paragraph 2 of the previous office action and for the additional reason set forth below.

The new limitations do not define over the prior art because such properties will obviously take place in the cookies of the prior art when different types of flavoring chips are used. For instance, the chips disclosed by Haynes et al are enhanced flavored chip; if such chips are used with regular chocolate chips, then some chips will have enhanced flavor composition over the other chips.

4. In the response filed Oct. 21, 2002, applicant argues while the prior art teaches combination of flavoring chips in cookies, there is no recognition that such variation in recipes would have any benefit toward solving the freshness loss problem. This argument is not persuasive. If different types of chip are added to cookies and the flavor of some chips are enhanced over the other, then the benefit of extending freshness will occur whether or not it is disclosed. Even if the prior art teaches adding different types of chip for different reason, the same end result as claimed is obtained if the chips added are different in flavoring composition. For example, the chips disclosed by Haynes et al are enhanced flavored chip; if such chips are used with regular chocolate chips, then some chips will have more flavoring composition over the other chips. If chocolate chips are used in combination with milk chocolate chips, the chocolate

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chips will have enhanced flavoring over the milk chocolate. The claims do not set how much greater is the concentration of the enhanced chips over the other chips; thus, any minute amount will be considered as greater amount. Applicant argues the recipes are not concerned with storage stability extending over several months. This argument is not commensurate with the scope of the claims. There is no limitation about storage stability extending over several months; the term "extended shelf life" does not equate to storage stability extending over several months. Applicant has not shown any comparative testing in shelf life and freshness of the claimed product over the prior art product.

5. Applicant's arguments filed Oct. 21, 2002 have been fully considered but they are not persuasive.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien Tran whose telephone number is 703-308-1868. The examiner can normally be reached on Wed-Fri. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

December 18, 2002


LIEN TRAN
PRIMARY EXAMINER
Group 1700